

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dorn et al.	
Patent No.: 7,589,127	Art Unit: 1621
Issue Date: September 15, 2009	
Serial No.: 10/511,661	Examiner:
Docket No.: 21058YP	O'Sullivan, Peter G.
Filed: October 18, 2004	
For: AMINOALKYLPHENOLS, METHODS OF USING AND MAKING THE SAME	Confirmation No. 4903

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT CALCULATION

Sir:

This is a request for reconsideration of the patent term adjustment (PTA) determination set forth in the Decision mailed April 21, 2010 on the Request for Recalculation of PTA in View of Wyeth ("Decision"). According to the Decision, the recalculation resulted in a PTA determination of 954 days. The Decision and The Patent Term Adjustment History from Public PAIR are attached as Exhibits 1 and 2 respectively. The recalculation is believed to be incorrect. It is believed the patent is entitled to 957 days of PTA.

Analysis

According to 37 CFR 1.702(a)(1), the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to mail at least one of a notification under 35 USC 132 or a notice of allowance under 35 USC 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 USC 371 in an international application. The requirements under section 371 for this international application were fulfilled on December 24, 2004. The date fourteen months after the section 371 requirements were fulfilled is February 24, 2006. A first office action under 35 USC 132 was mailed on August 7, 2007, which constitutes 529 days of Patent Office delay under 37 CFR 1.703(a)(1); i.e., it is the number of days beginning on the day after February 24, 2006 and ending on August 7, 2007.

According to 37 CFR 1.702(a)(3), the term of an original patent shall be adjusted if the Office response to a reply under 35 USC 132 is more than four months after the date on which the reply was filed. A reply to the first office action was filed on September 6, 2007. The date four months after the filing of the response is January 6, 2008. A non-final action was mailed June 16, 2008. This constitutes 162 days of Patent Office delay under 37 CFR 1.703(a)(2); i.e., it is the number of days beginning the day after January 6, 2008 and ending on June 16, 2008.

Under 37 CFR 1.702(b)(1), the Patent Office must issue a patent within three years after the date on which the national stage commenced under 35 USC 371(b) or (f), but excluding any time consumed by continued examination under 35 USC 132(b). The national stage commenced on December 24, 2004. The date three years after the commencement of the national stage is December 24, 2007. A request for continued examination was filed April 2, 2009. The patent issued September 15, 2009. This constitutes 464 days of Patent Office delay under 37 CFR 1.703(b)(1); i.e., it is the number of days beginning the day after December 24, 2007 and ending on September 15, 2009 excluding the number of days in the period beginning April 2, 2009 and ending on the date the patent was issued, which is $631 \text{ days} - 167 \text{ days} = 464 \text{ days}$.

The adjustment of 162 days due to Patent Office delay under 37 CFR 1.702(a)(3) and the adjustment of 464 days due to Patent Office failure to issue a patent within three years of the actual filing date of the application under 37 CFR 1.702(b)(1) actually overlap. Under 37 CFR 1.703(f) and the Wyeth decision, such instances of actual overlap cannot be counted twice in the determination of PTA.

There were no other circumstances giving rise to Patent Office delay.

According to 37 CFR 1.704(c)(10), the period of adjustment shall be reduced where the applicant submits an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed. The Notice of Allowance for the application was mailed on May 14, 2009. A supplemental declaration was filed by the Applicant on August 11, 2009. The notice in response to the filing of the declaration was issuance of the patent on September 15, 2009. This resulted in 36 days of Applicant delay under 37 CFR 1.704(c)(10); i.e., the number of days beginning on the date the supplemental declaration was filed and ending on the date the patent issued.

There were no other circumstances or actions that constituted Applicant delay.

It is further noted that the issued patent was not subject to a terminal disclaimer.

Accordingly, it is believed that the patent is entitled to 957 days of PTA; i.e., Patent Office delay less exclusions, overlap and applicant delay = (529 days + 162 days + 464 days) – (162 days + 36 days) = 957 days.

Request

It is requested that the PTA determination for this application be changed to 957 days, and a Certificate of Correction be issued reflecting 957 days of PTA.

The Commissioner is authorized to charge the fee required by 37 CFR 1.18(e) and any other charges which may be due as a result of the submission of this request to Deposit Account No. 13-2755.

Respectfully submitted,
By: /Kenneth R. Walton, Reg. No. 32,951/
Kenneth R. Walton, Reg. No. 32,951
Attorney for Applicants
MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel.: (732) 594-3462

Date: May 18, 2010

EXHIBIT ONE

Decision on Request for Recalculation of PTA
In View of Wyeth (Mailed April 21, 2010)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

MERCK
P O BOX 2000
RAHWAY, NJ 07065-0907

Mail Date: 04/21/2010

Applicant	: Conrad P. Dorn	: DECISION ON REQUEST FOR
Patent Number	: 7589127	: RECALCULATION OF PATENT
Issue Date	: 09/15/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/511,661	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 10/18/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **954** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(iii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

EXHIBIT TWO

Patent Term Adjustment History from Public PAIR

10/511,661

AMINOALKYLPHENOLS, METHODS OF USING AND MAKING THE SAME

05-11-

2010::16:05:17

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/511,661

Filing or 371(c) Date:	10-18-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	09-15-2009	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	954
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
04-17-2010	Petition Decision - Granted		
02-25-2010	Petition Entered		
09-15-2009	Recordation of Patent Grant Mailed		
08-26-2009	Issue Notification Mailed		
04-01-2009	PTA 36 Months	461	
09-15-2009	Patent Issue Date Used in PTA Calculation		
08-11-2009	Supplemental Papers - Oath or Declaration		36
08-12-2009	Application Is Considered Ready for Issue		⬆
08-11-2009	Issue Fee Payment Verified		⬆
08-11-2009	Issue Fee Payment Received		⬆
05-14-2009	Mail Notice of Allowance		⬆
05-13-2009	Document Verification		⬆
05-13-2009	Notice of Allowance Data Verification Completed		⬆
05-13-2009	Case Docketed to Examiner in GAU		⬆
04-02-2009	Information Disclosure Statement considered		⬆
04-02-2009	Information Disclosure Statement (IDS) Filed		⬆
04-15-2009	Date Forwarded to Examiner		⬆
04-15-2009	Date Forwarded to Examiner		⬆
04-02-2009	Request for Continued Examination (RCE)		⬆
04-15-2009	Disposal for a RCE / CPA / R129		⬆
04-02-2009	Information Disclosure Statement (IDS) Filed		⬆
04-02-2009	Workflow - Request for RCE - Begin		⬆
01-06-2009	Mail Final Rejection (PTOL - 326)		⬆
01-05-2009	Final Rejection		⬆
10-24-2008	Date Forwarded to Examiner		⬆
09-15-2008	Response after Non-Final Action		⬆
06-16-2008	Mail Non-Final Rejection		⬆
06-09-2008	Non-Final Rejection		⬆
02-18-2005	Information Disclosure Statement considered		⬆
09-17-2007	Date Forwarded to Examiner		⬆
09-06-2007	Response to Election / Restriction Filed		⬆
08-07-2007	Mail Restriction Requirement	529	
08-06-2007	Requirement for Restriction / Election	⬆	
10-28-2006	Case Docketed to Examiner in GAU	⬆	

08-30-2005	IFW TSS Processing by Tech Center Complete	⌵
08-30-2005	Case Docketed to Examiner in GAU	⌵
02-18-2005	Reference capture on IDS	⌵
02-18-2005	Information Disclosure Statement (IDS) Filed	⌵
02-18-2005	Information Disclosure Statement (IDS) Filed	⌵
07-19-2005	Cleared by OIPE CSR	⌵
07-19-2005	Cleared by OIPE CSR	⌵
07-12-2005	Cleared by OIPE CSR	⌵
12-24-2004	371 Completion Date	⌵
07-06-2005	Application Dispatched from OIPE	
07-06-2005	Notice of DO/EO Acceptance Mailed	

Close Window